

REMARKS

Reconsideration of this application is respectfully requested. Claims 43-58 are new and are derived from canceled claims 23, 25-30, and 32-37. No new matter enters by amendment. Upon amendment, claims 38-58 are pending in this application.

The Examiner contends that claims 23-27, 29-34, 36, and 37 are generic to Groups I-VIII because they contain multiple inventions, and that these claims will be examined to the extent that they contain elected subject matter if any of Groups I-VIII is elected. Applicants traverse this requirement.

37 C.F.R. § 1.141 states:

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that **more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided that application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (Section 1.75) or otherwise include all the limitations of the generic claim.**

Applicants' new claims 43-58, derived from canceled claims 23, 25-30, and 32-37, recite more than one species, but do not exceed a reasonable number of species. Claims 43 and 50 are generic to all the claimed species. All claims to species are dependent upon these claims and include all the limitations of the generic claims. Therefore, 37 C.F.R. § 1.141 permits applicants to have all of claims 43-58 examined in this application. Requirement for restriction to a single species is improper. Accordingly, applicants respectfully request that claims 43-58 be fully examined.

Serial No.: 09/492,697

Applicants recognize that the Examiner may require an election of species. See 37 C.F.R. § 1.146. Applicants request that the Examiner clarify if an election of species is required.

Furthermore, M.P.E.P. § 803.02 states:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), **it is improper for the Office to refuse to examine that which applicants regard as their invention**, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984).

Applicants submit that the Examiner's refusal to examine the full scope of applicants' generic claim 43 is improper. Applicants' claim 43 recites: "A recombinant mammalian chromosome comprising a Group I intron encoded endonuclease site." There has been no allegation or any explanation by the Examiner that the subject matter of this claim lacks unity of invention.

The invention of claim 43 cannot be considered to lack unity of invention. Claim 43 encompasses Group I intron encoded endonuclease sites, which are depicted in Fig. 6 of the specification. Group I intron encoded endonucleases can be classified into five classes: Class I I-endonucleases, Class II I-endonucleases, Class III I-endonucleases, Class IV I-endonucleases, and Class V I-endonucleases. (Specification at 27.) These are the classes recited in claims 44 and 51. I-SceI, I-SceIV, I-CsmI, and I-PanI are Class I I-endonucleases. (*Id.* at 47-48.) These are the endonucleases recited in claims

46 and 53. No lack of unity of invention exists. Since there is no lack of unity of invention, applicants respectfully request that claims 43-58 be fully examined.

In addition, M.P.E.P. § 809 states:

Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. See MPEP Section 809.03 for definition of linking claims. . . .

The linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability. Where such withdrawn claims have been canceled by applicant pursuant to the restriction requirement, upon the allowance of the linking claim(s), the examiner must notify applicant that any canceled, nonelected claim(s) which depends from or includes all the limitations of the allowable linking claim may be reinstated by submitting the claim(s) in an amendment. Upon entry of the amendment, the amended claim(s) will be fully examined for patentability.

M.P.E.P. § 809.03 further states:

The most common types of linking claims which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

(A) **genus claims linking species claims**

Applicants' claims are genus claims linking species claims. For example, claim 43 recites: "A recombinant mammalian chromosome comprising a Group I intron encoded endonuclease site." This claim recites the genus "Group I intron encoded endonuclease site." The Examiner has recognized that applicants' claims are generic. Paper No. 11 at 4. Class I I-endonuclease, Class II I-endonuclease, Class III I-endonuclease, Class IV I-endonuclease, Class V I-endonuclease, I-SceI, I-SceIV, I-CsmI, and I-PanI sites, as recited in claims 44-47, are species of Group I intron


Serial No.: 09/492,697

encoded endonuclease sites. Therefore, claim 43 is a genus claim linking claims 44-47. This linkage requires that claim 43 must be examined with the elected invention. All of applicants' claims depend from claim 43. Accordingly, applicants respectfully submit that the Examiner must fully examine claims 43-58.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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